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OFFICE OF PETITIONS

In re Application of :
OLOFSSON et al. :
Application No. 09/806,941 : DECISION ON PETITION
Filed: 05/21/2001 :
Attorney Docket No. TPP 31386 :

This is a decision on the "PETITION TO THE DIRECTOR TO SUSPEND THE RULES UNDER 37 CFR 1.183," filed December 4, 2007, requesting suspension of 37 CFR 41.47(b) and/or (g) and acceptance of the late filing of the Request for Oral Hearing.

Petitioners request a waiver of the requirement under 37 CFR 41.47(b) for filing a Request for Oral Hearing within two months of the date of the examiner's answer.¹ In support of the request, petitioners assert:

¹ 37 CFR 41.47 provides, in pertinent part:

(b) If appellant desires an oral hearing, appellant must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months from the date of the examiner's answer or supplemental examiner's answer.

(c) If no request and fee for oral hearing have been timely filed by appellant as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs "without an oral hearing.

(d) If appellant has complied with all the requirements of paragraph (b) of this section, a date for the oral hearing will be set, and due notice thereof given to appellant. ...

...

This case is on appeal and an Appeal Brief had been filed on July 24, 2006, and the Examiner's Answer having been mailed October 3, 2007. Thus, under 37 CFR Section 41.47(b) a request for oral hearing was due within two (2) [months] of the date of Examiner's Answer *i.e.*, by December 3, 2007. The matter was docketed for filing a Request for Oral Hearing by the staff of the undersigned's Firm for filing on December 3, 2007.

When such matter came up on the docket for December 3, 2007 the undersigned's legal assistant advised the undersigned that in anticipation of the change in the rules effective November 1, 2007, that a Request for Continuing Examination (RCE) had been filed in connection with the above-identified application, thereby mooting the Request for Oral Hearing.

In fact, the information conveyed to the undersigned was in error and no RCE had been filed and thus the date of December 3, 2007 to file a Request for Oral Hearing was still in effect. No Request for Oral Hearing was filed and the time for filing such request is not extendable under either 37 CFR 1.136(a) or (b).

...

Petitioner requests that in the interest of justice in an extraordinary situation that the Director suspend Rule 41.47(b) and/or (g) and accept the one-day late filing of a Request for Oral Hearing, as attached hereto.

Although the Patent Rules, specifically 37 CFR 41.47(b) specifies that the "Request for Oral Hearing" be filed within two months of the date of the Examiner's Answer,

(f) Notwithstanding the submission of a request for oral hearing complying with this rule, if the Board decides that a hearing is not necessary, the Board will so notify appellant.

(g) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time periods set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

there is no statutory requirement for that time period. In the present circumstances the date for filing is but one day later than the required due date and no intent to delay is occasioned by this late filing.

The Office will not be unduly prejudiced in accepting the one day late filing as it will not delay docketing of the Appeal at the Board of Patent Appeals and Interferences, nor ultimately delay resolution of this appeal.

The oral hearing is deemed necessary by petitioner to [sic: for] proper presentation of the issues on appeal, and while mindful of the Office position that an oral hearing may be refused even if timely requested, the undersigned's twenty years plus of extensive practice before the Board of Patent Appeals and Interferences, has found it helpful to the Board in understanding issues, though briefed, raise questions in the mind of the Administrative Patent Judges that can only be answered in person by counsel at the oral hearing.

Petition dated December 4, 2007, pp. 1-2. Petitioners also provided the Office with the Declaration of Legal Assistant, Marilyn V. Johnson, attesting to the facts in petition.

Pursuant to 37 CFR 41.47(b), an appellant must submit a written request for an oral hearing in a separate paper captioned "REQUEST FOR ORAL HEARING," accompanied by a fee, within TWO MONTHS after the date of the examiner's answer or supplemental examiner's answer. The Office notes that petitioners are under the mistaken belief that the two-month period may not be extended. In fact, the two-month period may be extended by filing a request under 37 CFR 1.136(b) (or under 37 CFR 1.550(c) if the appeal involves an ex parte reexamination proceeding). The rule further provides that the Board will consider the appeal and render a decision on the briefs without an oral hearing if any of the following occur: (1) the written request is not filed in a separate paper captioned "REQUEST FOR ORAL HEARING"; (2) the request is not timely filed; or (3) the request is not accompanied by the appropriate fee. MPEP 1209. Moreover, as noted by petitioners, notwithstanding the submission of a proper and timely Request for Oral Hearing, the Board may decide that a hearing is not necessary. Id.

The Office will grant a petition under 37 CFR 1.183, if an applicant demonstrates that (1) an extraordinary situation exists where (2) justice requires waiver of the rules. In this instance, the facts presented do not establish that either condition exists.

Petitioners' delay in filing the Request for Oral Hearing, as well as a request for an extension of time under 37 CFR 1.136(b), does not warrant the equitable tolling of the two-month period set forth in 37 CFR 41.47(b). There is no adequate showing that the belated filing of the Request for Oral Hearing, or the lack of filing of a timely request for an extension of time under 37 CFR 1.136(b) to file the Request for Oral Hearing, were caused by circumstances beyond petitioners', or petitioners' voluntarily chosen representatives', control.

Specifically, petitioners have not shown that an extraordinary situation exists to merit the granting of the petition, or even why an oral hearing is necessary in this case. Instead, petitioners' counsel has provided general comments on why counsel feels oral hearings are beneficial, and that a mistake was made in not filing the Request for Oral Hearing in a timely manner. The evidence presented on petition does not demonstrate that the denial of an opportunity for an oral hearing would prejudice petitioners such that an extraordinary situation exists which justice requires suspension of the time requirements of 37 CFR 41.47(b) and/or (g) to permit the late filing of a Request for Oral Hearing. Rather, the delay in timely filing a Request for Oral Hearing was due to a clerical error and counsel's reliance on a misstatement by his legal assistant.

It is well established that a party's inadvertent failure to comply with the requirements of the rules or procedures of the USPTO is not considered an extraordinary situation where justice requires waiver of the rules. See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995). Thus, circumstances resulting from petitioners', or petitioners' counsel's, failure to exercise due care or to properly apply the patent statutes or rules of practice are not extraordinary circumstances where the interests of justice require the granting of relief. See In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pat. 1990). A clerical inadvertence or error is not an adequate ground for requesting waiver of the regulations. See In re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994). Likewise, a party's avoidable mistake in filing papers is not an extraordinary situation that warrants waiver of the rules. Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994). An oversight or misunderstanding

that could have been prevented by the exercise of ordinary care or diligence is not an extraordinary situation within the meaning of 37 CFR 1.183. In re Tetrafluor Inc., 17 USPQ2d 1160 (Comm'r Pats. 1990); In re Choay S.A., 16 USPQ2d 1461 (Comm'r Pats. 1990); In re Bird & Son, Inc., 195 USPQ 586 (Comm'r Pats. 1977). Lastly, the Office should not relax the requirements of a rule to save an applicant from the consequence of his delay. See Ex Parte Sassin, 1906 Dec. Comm'r 205, 206 (Comm'r Pat. 1906) and compare Zeigler v. Baxter v. Natta, 159 USPQ 378, 379 (Comm'r Pat. 1968).


As petitioners have not provided an adequate showing of an "extraordinary situation" in which "justice requires" suspension of 37 CFR 41.47(b) or (g), the petition is **dismissed**. As petitioners did not file a timely Request for Oral Hearing, the appeal will be assigned for consideration and a decision will be made on the briefs without an oral hearing.

On December 12, 2007, petitioners submitted a Change of Correspondence Address, requesting that the Office change the correspondence address for the above-identified application to the address associated with Customer No. 74217 or the firm of STEVENS DAVIS MILLER AND MOSHER, LLP, 1615 L ST. NW, SUITE 850, WASHINGTON, DC 20036. However, the address associated with Customer No. 74217 differs from the address of the firm of STEVENS DAVIS MILLER AND MOSHER, LLP. 37 CFR 1.33(a) provides: "If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address." Accordingly, the Office will use the correspondence address associated with Customer No. 74217 for mailing of future correspondence to petitioners. A courtesy copy of the decision will be mailed to the address of the firm of STEVENS DAVIS MILLER AND MOSHER, LLP, which is also identified in the present petition.

The request for an extension of time for response within the first month, filed December 4, 2007, accompanied by a \$120.00 fee, is improper. As stated in 37 CFR 41.47(g), extensions of time under 37 CFR 1.136(a) are not applicable to the two-month period for filing a Request for Oral Hearing. Additionally, the \$1,030.00 fee for filing a Request for Oral Hearing is unnecessary. Therefore, the Office will refund both fees, totaling \$1,150.00, to the Deposit Account No. 19-4375.

The application is being referred to the Board of Patent Appeals and Interferences.

Telephone inquiries relevant to this decision may be addressed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.



Anthony Knight
Supervisor
Office of Petitions

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